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Diane Zimmerman

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FITTING PUBLICITY RIGHTS INTO INTELLECTUAL PROPERTY AND FREE SPEECH THEORY: SAM, YOU MADE THE PANTS TOO LONG!

Diane Leenheer Zimmerman¹

It is particularly fitting that a session of the Intellectual Property Section of the American Association of Law Schools on the right of publicity is the way his colleagues have chosen to honor Ralph Sharp Brown. Ralph Brown devoted much of his rich and varied professional and academic life to the two areas that come together in this discussion: intellectual property and freedom of speech. Most of you know him as a copyright scholar, but he was also a civil libertarian of great distinction who produced a body of important scholarship on the use of loyalty oaths and on issues of academic freedom and someone who gave generously of his time and considerable lawyerly skills to further the cause of protecting individual rights. I was actually introduced to him before I became deeply involved in teaching copyright law by a mutual acquaintance who served with Ralph as a member of the Board of the American Civil Liberties Union and who thought that we would enjoy sharing our deep interest in First Amendment issues. For many years, Ralph taught a well-regarded First Amendment seminar at Yale and at New York Law School on privacy, publicity and libel law.

It was clearly no accident, therefore, that when he was invited to give the Sixteenth Annual Donald C. Brace copyright lecture in 1986, he looked for a topic that reached beyond the confines of statutory copyright. Rather, he chose to address what he termed, in

¹ Professor of Law, New York University. I would like to offer special thanks to Professors Roberta Kwall and Marci Hamilton for their very perceptive and helpful comments on the draft of this paper. I hope I have learned from them, and that they will forgive me for what I have failed to learn.

his usual plainspoken and direct way, copyright's "upstart cousins," within which he included the right of publicity.²

Although he was careful to point out that he did not defend "spurious endorsements,"³ Ralph was not in other regards a great fan of publicity rights – any more than he was to become an admirer in later years of the trend toward ever-greater expansion of copyrights. In his lecture, he focused in particular on a variety of applications of the publicity right in areas other than commercial advertising. He wrote that:

I continue to have trouble with the notion that if I sculpt a bust of Martin Luther King, dead or alive, I cannot sell copies of it, even when I make no false claim that it is sponsored by Dr. King or the Foundation that honors his memory. Similarly, I have trouble with the notion that I cannot recreate the Marx Brothers in my own blend of their style of comedy and that of Chekhov. I have even more trouble with the notion that I cannot do an Elvis

2 Ralph S. Brown, *Copyright and Its Upstart Cousins: Privacy, Publicity, Unfair Competition: The Sixteenth Donald C. Brace Memorial Lecture*, 33 J. Copyrt. Soc. 301 (1986)[hereinafter Brown, *Upstart Cousins*]. The right of publicity, like appropriation (its close kin in privacy law), prohibits commercial uses of a variety of elements of identity without prior permission. Publicity rights in personas differ from privacy rights in personas because publicity rights are property rather than personal interests. Publicity rights can be sold, and in many jurisdictions survive beyond the lifetime of the creator.

3 *Id.* at 304. The earliest cases involving commercial uses of identity were ones in which defendants used the name or face of a private person, who did not seek celebrity, in their advertising or product promotions. See *Roberson v. Rochester Folding Box Co.*, 171 N.Y. 538, 64 N.E. 442 (N.Y. 1902) (plaintiff's face used on packages of flour). The first state to recognize a privacy right in such cases was Georgia. The case involved a "spurious endorsement" in that the insurance company made up a testimonial and attributed it to the plaintiff. *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905). *Roberson*, in contrast, simply used the plaintiff's face as an attractive illustration on the packaging. Whether or not this constituted a "spurious endorsement" is not quite so clear. Nevertheless, to the extent that publicity cases are about problems of falsification in advertising, rectification does not require a property right in personality that is both alienable and descendible.

Presley act without coming to terms with a corporate licensing enterprise.⁴

Although there is much to be said about the problems publicity rights cause even in the area of advertising,⁵ I would like to take my lead in this discussion from Ralph and focus, as he did, on so-called commercial uses that are not designed solely to encourage others to buy products or services. In addition to selling commemorative busts of famous people⁶ or imitating their performances (the examples Ralph gave), this category includes a diverse set of practices, including using well-known names and faces (or, in some jurisdictions, using fictional characters associated with particular actors) on clothes, trading cards, posters and buttons - or even using celebrities to illustrate some forms of editorial content in a magazine or newspaper.

Ralph identified a set of specific failings of the right of publicity as applied to such activities that, in his view, undercut its

4 Brown, *Upstart Cousins*, *supra* note 2, at 305

5 I have addressed this subject in detail in a previous article. Diane Leenheer Zimmerman, *Who Put the Right in the Right of Publicity?*, 1998 Symposium on Privacy and Publicity in a Modern Age: A Cross-Media Analysis of the First Amendment. 9 DEPAUL J. ART & ENT. LAW 35 (1998) [hereinafter Zimmerman, *Publicity*].

6 I speak here of famous people or celebrities, but in literal fact, in many, if not most, jurisdictions today, anyone could claim a right of publicity if her identity were used in a "commercial" way. See *Martin Luther King, Jr. Center for Social Change, Inc. v. American Heritage Products, Inc.*, 296 S.E.2d 697, 703 (Ga. 1982) (person need not be a celebrity to enjoy a right of publicity); IND. CODE ANN. § 32-13-1-6 (Michie 1995) (if personal attributes have commercial value for any reason, right of publicity applies). In California, for example, if a person did not exploit her persona commercially during her lifetime, the possibility of doing so for seven decades after her death can be preserved by the executor or administrator of her estate by registering with the Secretary of State and paying a \$10 fee. CAL. CIV. CODE § 3344.1 (Deering 2000). The provision does not require that the deceased have been famous. The so-called appropriation right, a branch of privacy law, has never required that the plaintiff be famous. It can be used as an alternative cause of action by living persons complaining of non-advertising uses. See, e.g., *Mendonsa v. Time, Inc.*, 678 F. Supp. 967 (D. R.I. 1988) (finding that sale of photograph, showing a sailor - ostensibly the plaintiff - kissing a woman in Times Square at the end of World War II was a commercial use in violation of applicable privacy laws).

legitimacy and made it a poor fit into any properly ordered body of intellectual property law. He worried that the right of publicity was “extending its reach into the preserve of ideas,”⁷ which ought to remain part of the public domain. He raised a metaphoric eyebrow at some of the justifications offered for the breadth of the interest, and he complained that it lacked theoretically appropriate boundaries. In his view, certain standards set for copyright (but missing from publicity rights law) provided essential checks and balances, and needed to be present in any property right involving expressive matter.

The three requirements he identified were respect for the idea/expression dichotomy, firm limits on duration, and the existence of a generous privilege of fair use. Unfortunately, in the decade and a half since Ralph’s thoughtful Brace Lecture, the fit of right of publicity into the intellectual property “suit” has not improved.⁸ If anything, mis-sizing is even more acute today than when he first called our attention to it. The idea/expression divide has been ever more hopelessly muddled as the breadth of attributes protected by publicity rights has grown in many states to a point one might be tempted to describe as metaphysical.⁹ No longer are

7 Brown, *Upstart Cousins*, *supra* note 2, at 304.

8 Several more recent critics have pointed out in greater detail a myriad of problems with publicity rights and their steady expansion. See, e.g., Rosemary J. Coombe, *Author/izing the Celebrity: Publicity Rights, Postmodern Politics, and Unauthorized Genders*, 10 CARDOZO ARTS & ENT. L. J. 365 (1992) [hereinafter Coombe, *Author/izing the Celebrity*]; Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing the Lanham Act and Rights of Publicity*, 20 COLUM.-VLA J. L. & ARTS (1996); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 127 (1993). One of the earliest critics of publicity rights, whose work was quoted in Ralph’s lecture and whose influence remains visible in the work of subsequent scholars is David Lange. See, David Lange, *Recognizing the Public Domain*, 44 J. LAW & CONTEMP. PROBS. 147 (1981) [hereinafter Lange].

9 Actually, it would be interesting to consider how much of the right of publicity could survive a rigorous application of the idea/expression division that limits copyright. The United States Supreme Court has upheld the right of publicity in one case, and it involved one of the few instances where one could reasonably talk about a violation of publicity interests as taking “expression” rather than ideas or facts. In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433

we concerned with the use of clearly identifiable names and faces. Mere “suggestion” will do quite well, say, for instance, a voice or a face that resembles someone else’s;¹⁰ or a mixture of visual cues that “conjure up” the image of a celebrity (for example, a robot in a blond wig and red gown standing before a game board).¹¹

The durational boundaries of the right have also become more generous in many jurisdictions than those to which copyright holders in their most covetous moments have yet aspired. Copyrights, as a constitutional matter, can only last for a limited time - currently (and controversially), for the life of the author plus 70 years.¹² But publicity rights now endure in some places for as much as a century after the person’s death, and, in one state, have the potential to last forever.¹³ No functional equivalent of “fair use” has evolved, either. It is true that publicity rights cannot be enforced where the defendant makes a “newsworthy” use of someone’s identity, but that is hardly the equivalent of fair use. Rather, newsworthy uses fall outside the property right and therefore do not “infringe” it in the first place. A fair use would excuse an otherwise infringing “commercial” use -- and that is

U.S. 562 (1977), the Court ruled that a publicity claim survived a First Amendment defense where the defendant broadcaster photographed and played on a news show the plaintiff’s entire act from start to finish. The taking was not of a face or a name, or even a style of performing, but rather of a discrete performance by a particular individual.

10 See, e.g., *Midler v. Young & Rubicam, Inc.*, 849 F.2d 460 (9th Cir. 1988), cert. denied, 503 U.S. 951 (1992) (actress and singer Bette Midler’s publicity right infringed by use of singer with a similar voice in a car commercial).

11 *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992) reh’g denied, 989 F.2d 1512 (9th Cir. 1992), cert. denied, 508 U.S. 95 (1993) (game show hostess Vanna White’s publicity right infringed by parody in advertisement).

12 Digital Millennium Copyright Act (DMCA), Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified in scattered sections of 17 U.S.C.).

13 Indiana and Oklahoma provide protection for the life of the person plus 100 years, IND. CODE ANN. § 32-13-1-8 (Michie 1995); OKLA. STAT. 12, § 1448-49 (1991). Tennessee preserves the right for ten years, but permits heirs and assigns who exploit publicity values during that time to preserve them unless and until they abandon their use for two years – a potential right in perpetuity. TENN. CODE ANN. § 47-25-1104 (1997).

something that virtually never occurs in the right of publicity case law.¹⁴

Why have publicity rights continued to take a direction that seems to fail most, if not all, of Ralph's suggested tests for an appropriately tailored property right in information? I regret to say that I think the answer lies in a flaw in Ralph's basic premise. He had an abiding faith that intellectual property law had an internal coherence, and that from it one could generate a set of rational constraints that would mark off the border between what could be commodified and what must remain in the public domain. He, I think, believed that courts and legislatures would ultimately be

14 I can think of two possible cases that might exemplify something akin to a "fair use" defense. Both involved the use for commercial purposes of the names or faces of political figures. The first was a suit by comedian Pat Paulsen during his candidacy for President of the United States. Paulsen objected to the use of his image on posters, but the court declined to allow him to enjoin the use either under a New York statute prohibiting commercial uses of identity, N.Y. CIV. RTS. §§ 50-51 (McKinney 1998) or on the grounds that his publicity rights were violated. The court said the use was protected as newsworthy, even if Paulsen's campaign was a publicity stunt rather than a serious effort. The court did, however, leave open the possibility that Paulsen could sue for damages. *Paulsen v. Personality Posters, Inc.*, 299 N.Y.S.2d 501, 507-08 (N.Y. Sup. Ct. 1968). The second, also arising under the New York statute, involved the use of New York Mayor Rudy Giuliani's name in an advertisement for New York Magazine. The trial court found the use privileged under the First Amendment, in part as parody, and the Second Circuit affirmed, albeit on somewhat different grounds. *New York Magazine v. Metropolitan Transportation Authority*, 987 F. Supp. 257, 268-69 (S.D.N.Y. 1997), *aff'd* 136 F.3d 123 (2d Cir.), *cert. denied*, 119 S.Ct. 68 (1998). There may be other examples, but assuredly not many. The Ninth Circuit, for instance, did not recognize any special privilege for an obvious use of parody in advertising in the Vanna White litigation. *White*, 971 F.2d 1395 (9th Cir.), *reh'g denied*, 989 F.2d 1512 (9th Cir. 1992), *cert. denied*, 508 U.S. 951 (1993). Nor was a district court in Texas inclined to privilege the wit in a playful advertisement for men's shirts. The ad showed a man, identified as Don, wearing a "henley" brand shirt. The caption referred to the shirt as "Don's henley." Musician Don Henley prevailed on his right of publicity claim. *Henley v. Dillard Dept. Stores*, 46 F. Supp. 2d 587 (N.D. Tex. 1999).

guided by these constraints. Fifteen years ago, that view was still plausible.¹⁵

In those halcyon days, copyright, patent law and other forms of intellectual property were still generally thought of as means used to achieve important public benefits. The limited monopoly provided by copyright, for instance, was intended to give authors enough of an incentive to create new works, but not more. At the point where additions to the statutory monopoly could not convincingly be shown to net the public at least an equivalent increment of value in return, further protection could not be justified.¹⁶ Copyright was understood as maintaining a critical balance, protecting specific works of authorship, while simultaneously preserving the building blocks of expression -- ideas, facts and theories -- free for the use of all.¹⁷ A rich public

15 Many of the most respected intellectual property scholars working today continue to argue that the theory and structure of intellectual property rights imposes limits on how far property interests can be expanded. See, e.g., Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L. J. 1533 (1993) (arguing that copyright theory, properly understood and applied, would protect speech values); Marci A. Hamilton, *The TRIPS Agreement: Imperialistic, Outdated, and Overprotective*, 29 VAND. J. TRANSNAT'L L. 613 (1996) (arguing that intellectual property limits overstepped by TRIPS); Mark A. Lemley, *Beyond Preemption: The Law and Policy of Intellectual Property Licensing*, 87 CALIF. L. REV. 111 (1999) (criticizing proposed modifications of Uniform Commercial Code as violating copyright norms); J. H. Reichman & Pamela Samuelson, *Intellectual Property Rights in Data?*, 50 VAND. L. REV. 51 (1997) (arguing that aggressive protection of databases violates copyright norms). I do not disagree with their theoretical points, but argue that, as a practical matter, legislation, international trade agreements and even judicial decisions have chosen to ignore those theoretical boundaries to an extent that makes it difficult for me to state that they continue to have any real life left in them.

16 A classic statement of this position with regard to copyrights appears in *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); with regard to patents, see *Graham v. John Deere Co.*, 383 U.S. 1, 5-10 (1966). This thesis remains alive among a large portion of the academic community involved with intellectual property, although it is on the decline elsewhere. See scholars cited in note 14, *supra*.

17 See, e.g., *Feist Publications, Inc. v. Rural Telephone Service*, 499 U.S. 340, 349-50 (1991) (only original expression can be protected; the ideas and information in a work are free for others to build upon).

domain was not a byproduct of copyright, but an essential part of the package. It was necessary, not only for public edification and enjoyment, but to assure that successive generations of creators would have unfettered access to the raw materials from which to fashion new works.¹⁸ By analogy, those forms of intellectual property rights in information not provided for in the Constitution ought to be supported by a similar set of convincing justifications, be animated by considerations of the public weal, and ought not to remove from the public domain any more material than absolutely necessary to achieve their goals.

Sadly, as a matter of positive law, that consensus, and hence any basis for relying on intellectual property theory as a source of limitations, has, in my opinion, evaporated.¹⁹ Even within copyright law itself, the careful compromises between private profit and protection of the public domain show signs of eroding.²⁰

18 The case for the importance of a rich public domain has been made particularly well by Professors Jessica Litman, David Lange and Yochai Benkler. Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354 (1999); Jessica Litman, *The Public Domain*, 39 EMORY L. J. 965 (1990); Lange, *supra* note 8.

19 There are occasional heartening exceptions, however, that must be gratefully acknowledged. The Eleventh Circuit, for example, recently ruled that a first sale doctrine modeled after that in copyright applies to the right of publicity. As a result, the widow of a deceased automobile racer was unsuccessful in her claim that a retailer who legally obtained authorized sports trading cards and then mounted them on plaques had violated the racer's right of publicity. *Allison v. Vintage Sports Plaques*, 136 F.3d 1443 (11th Cir. 1998). When I say that the consensus has evaporated, I speak, of course, of the consensus among legislators and judges. Members of the academy continue bravely to defend the existence of limits within intellectual property law to a continuous expansion of property rights, but with only limited success. See note 14, *supra*.

20 In retrospect, the most dramatic erosion of the public domain occurred in 1976 when Congress, in the new Copyright Act, declared that henceforth a work of authorship would be covered by copyright once it was fixed in tangible form. Whatever the drawbacks of the 1909 Copyright Act and its predecessors, they did not presume that everything from a casual posting on a bulletin board to the great American novel were automatically intellectual property entitled to federal protection. Once a work was "published," the author had to comply with particular conditions to obtain and retain statutory protection. More modern

But, certainly, whenever copyright rules are too “inflexible” to protect a prospective source of value embodied in an information good, the prevailing view is that we should find some other body of law, invented or reinterpreted, to “take care of the problem.” Copyright does not protect “sweat of the brow” in compiling facts? Then we need to “correct” this flaw by a new law to protect collections of information.²¹ If celebrity has value to the public, we ought to create new rights to capture that value, and perhaps expand as well our definitions of trademark and unfair trade practices to take care of any unforeseen contingencies.²²

Possibly because intellectual property today is seen through the lens of trade policy rather than through the more abstract lens of information policy, authors, creators, their heirs and assigns have received willing support from government agencies, legislators and courts for their belief that they are entitled to as much as the market will bear in return for the contributions they make to the social good. The public interest has been largely disarmed as a counterweight to the claims of private owners by a semantic slight of hand that treats the public interest as automatically furthered by whatever benefits authors and owners. Under this philosophy, it is only a slight exaggeration to fear that the public domain will be transmuted from an essential element of our shared intellectual capital into the equivalent of a solid waste transfer station for those dregs of information generally conceded to be worthless.

examples of changes in copyright law that reduce the public domain include provisions allowing lapsed copyrights to be restored, 17 U.S.C. § 104A (2000) and increasing the term of copyrights. *Id.* at § 302. Users’ ability to exploit specific copies of work they have purchased has also been reduced by cut-backs in the first sale doctrine. *Id.* at § 109 (b). This is further threatened by the protection provided to security devices that limit access to materials distributed in digital form. DMCA, *supra* note 12.

21 See e.g., Collections of Information Antipiracy Act, H.R. 354 (106th Cong., 1st Sess.)(1999) (bill to protect databases).

22 For interesting discussions of the expanding concepts of trademark and unfair trade practices, see Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, Symposium, 108 YALE L. J. 1687 (1999); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, Symposium, 108 YALE L. J. 1717 (1999).

Although I part company, reluctantly, with Ralph Brown's faith in the self-limiting nature of intellectual property, I continue to believe that firm limits do exist to the commodification of information and ideas. But I would argue that they are far more likely to come from the First Amendment than from the copyright clause.²³

Intellectual property scholars are chary of talking about the First Amendment.²⁴ Indeed, much of the literature about such obvious candidates for scrutiny under that provision, such as the proposed database legislation, barely mentions the possibility that it would be unconstitutional to grant private ownership in facts. In that regard, the right of publicity has been somewhat unusual because, from its earliest roots in the tort law of privacy, writers have acknowledged that the First Amendment plays a limiting role²⁵ -- although as I have argued elsewhere, the how large a role has been greatly and continuously underestimated.

I would like to begin this conversation about property rights in information, therefore, by laying out a different set of premises from Ralph's and argue that they ought to underpin our understanding of the kinds and extent of the rights that can legitimately be recognized. First, I would argue that copyright rests on a different footing from other property rights in information goods. The commodification of original writings by authors is provided for in the Constitution. No other form of property interest in informational works has a similar constitutional basis. Hence, any form of property right in informational material that is not provided for under the copyright clause should be

23 Congress often legislated intellectual property rights that do not meet the standards for copyright under its commerce power, and the states have similarly evolved intellectual property rights without running into serious limits, at least this far, from preemption.

24 Two notable exceptions are Jessica Litman and Yochai Benkler. *See, e.g.,* Jessica Litman, *Copyright and Information Policy*, 55 LAW & CONTEMP. PROBS. 185 (1991); Benkler, *supra* note 18

25 *See, e.g.,* J. Thomas McCarthy, *The Rights of Publicity and Privacy*, § 8.6 (Rev. 1998); Roberta Kwall, *The Right of Publicity vs. the First Amendment: A Property and Liability Rule Analysis*, 70 IND. L.J. 47 (1994); Peter L. Felcher & Edward L. Rubin, *The Descendibility of the Right of Publicity: Is There Commercial Life After Death?*, 89 YALE L.J. 1125 (1980).

required to meet the same tests for validity that are applied to other forms of government regulation of speech. This standard will be difficult to meet because, in my view, these common law and statutory provisions are content-based, rather than content neutral.²⁶

The question of free speech limitations on intellectual property outside copyright cannot be avoided by the semantic sleight of hand that is accurately described by Bela Lugosi, Jr., in his contribution to this symposium. Mr. Lugosi says, correctly, that

26 A content-based regulation of speech can only be upheld if the rationale supporting it meets a compelling state interest test. *Simon & Schuster, Inc. v. Members of New York State Crime Victims Board*, 502 U.S. 105, 116 (1991). Content-neutral regulations can be justified merely by the assertion of an important or substantial interest. See generally *United States v. O'Brien*, 391 U.S. 367 (1968). I would argue that publicity rights rules are content-based because, as in *Simon & Schuster*, they are directed entirely at speech activities and are defined by a particular subject matter. Compare *Erznoznick v. City of Jacksonville*, 422 U.S. 205 (1975) (ban on exhibition of nudity on movie screens visible from streets content-based) with *United States Civil Service Comm'n v. National Ass'n of Letter Carriers*, 413 U.S. 548 (1973) (ban on political activity by federal employees not content-based even though it impacts on political speech). The distinction between content-based and content-neutral, however, can be difficult to discern and has led the Court into many determinations that appear to be quite inconsistent with one another. Two circumstances might argue for lower levels of scrutiny for content-based regulation of speech. First, the Court has intimated that some noncommercial speech might be subjected to restrictions on less strict standards of review because it is less valuable than core first amendment speech. See, e.g., *FCC v. Pacifica Foundation*, 438 U.S. 726 (1978) (Stevens, J., for plurality). Or speech may be restricted because of its "secondary effects." *Renton v. Playtime Theatres, Inc.*, 475 U.S. 41 (1986). The problem with the first rationale is line-drawing. Either "core" speech must be restricted to some very narrow category like speech directly about the political system (leaving lots of very valued speech with less protection) or the line must be drawn according to some subjective evaluation by judges of which speech is and is not worthy -- a highly objectionable process. As for the secondary effects rationale, it has been applied in cases where the government claims that it intends to prevent non-speech effects like crime (the secondary effect that led to upholding limits on bookstores, theaters and so on, offering "adult entertainment"). It is not clear that the government's desire to prevent economic losses to individuals through unconsented uses of information about themselves can properly be called a "secondary effect." Rather, it is a rejection on the free speech side of any role for the public domain.

“courts have noted that the First Amendment’s protection of free expression does not afford infringers the right to appropriate legally recognized property and intellectual property rights.” But what courts leave out when they fall back on this formulation is that whether or not something can be a “legally recognized” right is itself a determination that must be informed by the First Amendment. The mere fact that information,²⁷ were it privately controlled, could generate income for an owner does not, standing alone, provide a sufficient justification for its commodifying it and placing it beyond the reach of First Amendment analysis.

That is, of course, not to deny that property rights in information can exist outside the copyright clause. The Supreme Court has recognized trademarks, unfair trade practices and trade secrets law as well as rights of publicity and misappropriation as forms of intellectual property rights that can limit the use of information. I would argue, however, that the scope given to these rights by the Court has tended to be quite narrow.²⁸ The only right of publicity case ever upheld (or for that matter, decided) by the Court, for example, involved a broadcast, without permission, of a

27 I use the word “information” here in its most capacious sense, in part for want of a better term. What I mean by it is all material that is intended to communicate, whether the communication be of facts or feelings or an aesthetic sensibility. I understand all these elements of communication to receive the First Amendment’s protection, thus grouping the visual arts, poetry and fiction along with the contents of the daily newspaper. When someone wears a shirt with a celebrity’s face on it, I would argue that the use is communicative and that it conveys “information.”

28 The fact that the exceptions are narrow does not, however, mean that they are never problematic from the perspective of the First Amendment. See, e.g., *San Francisco Arts & Athletics, Inc. v. United States Olympics Comm.*, 483 U.S. 522 (1987). In that case, the Supreme Court upheld the exclusive right of the United States Olympics Committee to use the word “Olympics” and denied use of the term to a group running what they had called the “Gay Olympics.” One might have supposed that the word “Olympics” was one of those important building blocks in the public domain, but the Court did not so find. For an excellent analysis of the case and the problem it raises, see Rochelle C. Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 68 NOTRE DAME L. REV. 397 (1990).

performer's entire act.²⁹ The most unabashedly broad property right ever recognized by the Court was that of a news service in the contents of its uncopyrighted reporting.³⁰ Although the Court continues to cite to this opinion from time to time, the general consensus is that subsequent developments in First Amendment case law have largely eroded the misappropriation doctrine on which the holding relied.³¹ I will examine some of the justifications for these exceptions in more detail later in the course of discussing publicity rights, but suffice it to say for now that, in my opinion, they are not capacious enough to support much of the current expansion of intellectual property law.

As I mentioned previously, both its advocates and opponents have always agreed that the scope of any possible property interest in publicity is limited by the free speech clause of the Constitution. If a use of a celebrity's identity occurs in a "newsworthy" setting, the use does not, all concede, violate any property right.³² But matters quickly go awry because the flip-side assumption seems to be that if a use is not newsworthy, it must perforce be commercial. And if it is commercial, then it does not have a First Amendment dimension and is fair game for regulation.³³

Whatever sense this dichotomous approach may have made in the early history of publicity's evolution, before the courts began to expand the First Amendment beyond news to art and entertainment

29 *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977). Once the Court found a protectable property interest, however, it rejected the argument that, because the broadcast occurred as part of a news program, that it was privileged by the First Amendment.

30 *International News Service v. Associated Press*, 248 U.S. 215 (1918).

31 Restatement (Third) Of Unfair Competition, § 38, comments b and c (1995) (expressing great skepticism about the validity of the misappropriation doctrine and urging at most a very narrow application of it); *National Basketball Ass'n v. Motorola*, 105 F.3d 841, 852 & n. 7 (2d Cir. 1997) (recognizing a very narrow role for misappropriation and observing the disrepute into which the doctrine has fallen).

32 The border between newsworthy and nonnewsworthy, however, is becoming increasingly contested. See, e.g., *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp.2d 897 (C.D. Cal. 1999) (applying right of publicity to article about fashion).

33 Zimmerman, *Publicity*, *supra* note 5 at 57-59.

as well,³⁴ once the expansion occurred, this division quickly ceased to be reasonable. The assumptions underlying publicity law became even more problematic when the Court extended an intermediate level of First Amendment protection to commercial speech.³⁵ Now “commercial” speech, too, is inside the First Amendment, even if protected by a less rigorous set of rules than other kinds of protected speech. It is important to add, however, that what the Supreme Court calls “commercial speech” and what counts as “commercial” in publicity law are not identical categories. The Supreme Court since the mid-1970s has experimented with – but not settled on – various definitions of commercial speech, including “speech that promotes a commercial transaction”³⁶ and “expression related solely to the economic interests of the speaker and its audience;”³⁷ however, the quest for a definition ultimately comes out, it seems fairly clear that the Court is talking about a category limited to advertising or other speech directly promoting the sale of products and services, and not about communications that are engaged in to make money.³⁸ In short, therefore, it appears that the kinds of “commercial” activities that Ralph Brown thought were troubling places to apply publicity rights are, in many circumstances, fully protected speech.

34 See, e.g., *Joseph Burston, Inc. v. Wilson*, 343 U.S. 495 (1952) (motion pictures are protected speech even though they are designed to entertain rather than to inform).

35 *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976).

36 *Id.* at 760-62.

37 *Central Hudson Gas & Electric Corp. v. Public Service Comm’n*, 447 U.S. 557, 561 (1980).

38 See, e.g., *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 423 (1993); *Board of Trustees of the State University of New York v. Fox*, 492 U.S. 469, 473-74 (1989). Even where a product or service is promoted by the speech, it may nevertheless be fully protected, see, e.g., *Bigelow v. Virginia*, 421 U.S. 809 (1975) (paid advertisement communicating information about abortion services is fully protected speech). I have argued elsewhere that changes in the law governing commercial speech probably give more First Amendment protection to advertising than the right of publicity currently recognizes. I will not, however, discuss those arguments here. See Zimmerman, *Publicity*, *supra* note 5, at 67-80.

This analysis gives new punch to the questions Brown asked in his Brace lecture. Why shouldn't an Elvis Presley imitator be allowed to put together a show based on old Elvis songs as long as he does not violate any copyrights and does not try to pass himself off as the real thing? Why shouldn't someone make and market a bust of Martin Luther King -- or for that matter use famous names or faces on T-shirts, or on baseball trading cards, or in commemorative memorabilia? Isn't all of it protected speech?

The response that cuts this argument to shreds does not leap off the pages of the legal literature or the judicial decisions. Courts have tried a number of justifications for their very broad definition of commercial use, ranging from the argument that the maker of the offending work "merely" wants to make a profit from it,³⁹ to one that the work lacked a sufficient "creative component" or enough social value to constitute protected speech.⁴⁰ These rationales have led legislators and courts so far in some jurisdictions that the editorial content of publications is now subject to the publicity right if the particular use at issue is deemed not to constitute "news" but, rather, crass commercialism.⁴¹ Courts have become too comfortable over the years with the mantra that non-advertising "commercial" uses are a violation of property rights rather than an appropriate exercise of a free speech right to question it.⁴² But question it they should.

39 *The Martin Luther King, Jr., Center for Social Change, Inc. v. American Heritage Products, Inc.*, 296 S.E. 2d 697, 702 (Ga. 1982).

40 *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1359 (D.N.J. 1981).

41 *Hoffman v. Capital Cities/ABC, Inc.*, 33 F. Supp. 2d 867 (C.D. Cal. 1999) (Dustin Hoffman's head, made up as the character Tootsie, superimposed on body of model for a magazine article on current fashion).

42 One notable exception is *Cardtoons, L.C. v. Major League Baseball Players Ass'n.*, 95 F.3d 959 (10th Cir. 1996). The Court of Appeals found that Oklahoma's right of publicity statute was unconstitutional as applied to baseball cards. The court found that the cards were fully protected speech. This holding is striking in particular because baseball cards were the first subject matter of a right of publicity case. In *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir.), *cert. denied*, 346 U.S. 816 (1953), Judge Jerome Frank determined that famous people had a property interest in the use of their names or faces that allowed them to control the use by others of those assets for their own profit. Unlike a privacy right, this one was not personal to the

A simple example demonstrates why. Let us assume that an artist uses the likeness of a well-known person as the subject of an original painting or a drawing. Has the artist violated the publicity rights of that individual, or has she instead engaged in protected activity? This question has not, so far as I know, been definitively decided by any court, but several publicity statutes specifically exempt “original works of art.”⁴³ It seems a stretch to imagine, in any event, that the Supreme Court, which in other contexts, has said that publicly available information about other people can virtually always be used in the protected speech activities of others, would require an artist to obtain a license to use a face before she could paint it.⁴⁴ Once the law begins down that path, it becomes difficult to explain why any information about living or dead people should be available free to anyone who wants to use it to produce speech protected by the First Amendment.⁴⁵ But freedom of speech, without a vast public domain to feed it, would be akin to freedom to breathe, but only if you first buy the air. One could certainly conceive “freedoms” or “rights” that could be exercised

individual and could be conveyed. The celebrity in the case had conveyed exclusive rights to use his name and face on trading cards to one company, and then went on to enter into a similar agreement with a second.

43 See, e.g., CAL. CIV. CODE § 3344.1(A)(2) (West 2000); FLA. STAT. ANN. § 540.08 (1999); 765 ILCS 1075/35(b)(1).

44 Many well-known artists have used recognizable images in their work. Andy Warhol’s use of the face of Marilyn Monroe is but one example. In a right of privacy decision, the United States Supreme Court cautioned that individuals did not have any general right to prevent the use of their identity or facts about themselves in the speech of others. “Exposure of the self to others in varying degrees,” wrote Justice Brennan for the Court, “is a concomitant of life in a civilized community. The risk of this exposure is an essential element of life in a society which places a primary value on freedom of speech and of press.” *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967). The *Hill* case involved use of identifying information about real people in a fictional dramatization.

45 I realize that information is paid for on a regular basis, and I do not suggest that there is anything wrong with that. Books, newspapers, newsletters, television programming are all sold in one way or another. What I mean by “free” in this context is that, once an individual gains access to information, whether by purchasing an information package that contains it or by other means, the information can be used without a need to obtain a license or pay any additional sum for the privilege. If information in the public domain is obtained, its reuse is “free.”

only if individuals had the wherewithal to pay for the privilege, but I do not think this society has ever considered freedom of speech using lawfully obtained, uncopyrighted, facts, ideas, theories and images in that way. Indeed, it is difficult to see how either the political or the autonomy functions of the First Amendment could be fulfilled for each individual in so radically commodified an information environment.

If you accept the initial premise, therefore, that an artist's original work of art is protected speech, one must also assume that selling the work to a patron for money, while commercial in nature, does not strip away First Amendment protection for what the artist has produced. The Supreme Court has said many times that speech does not lose its protected status simply because a motive for engaging in it is to make money.⁴⁶

So what does mark the divide between information uses that a celebrity can and cannot control? A California appellate court recently tried to wrestle with this question, and the difficulties it experienced are instructive.⁴⁷ Saderup, an artist, started by making a charcoal sketch of the deceased comedians known as the Three Stooges, an activity for which, based on our previous analysis, he presumably needed no permission.⁴⁸ The hard question, then, is why did Saderup's next move, in the Court's view, push him across the line into a violation of the actors' property rights. He used his sketch as a master from which to produce silk-screened images on T-shirts and lithographed posters, and, it is true, sold them at a profit -- at the time of the suit, some \$75,000 worth.

If it was permissible to use the images of the Three Stooges for the original sketch, and if Saderup was entitled to sell the original sketch without losing constitutional protection for his choice of subject matter, why did he lose that protection by proliferating

46 *Riley v. National Federation of the Blind of North Carolina*, 487 U.S. 781, 801 (1988); *First National Bank of Boston v. Bellotti*, 435 U.S. 765, 784 (1978); *New York Times Co. v. Sullivan*, 376 U.S. 254, 266 (1964).

47 *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 80 Cal. Rptr. 2d 464 (Cal. App. 1999). The case is now on appeal to the California Supreme Court.

48 The court assumed, *arguendo*, that the original charcoal sketch was exempt from the publicity right under applicable California law because it was a work of "fine art." *Id.* at 471.

copies of his work? The court intimated that making multiple copies was what made the difference between protected and unprotected activity.⁴⁹ But a poem is protected by the First Amendment whether it exists in a single manuscript or is reproduced by its author thousands of times. The protection given to a work of art is presumably similar to that provided for literary works. It is hard to understand, therefore, why *Saderup*'s sketch should lose its status as protected expression somewhere along the route from a single original to multiple signed and numbered copies, to an image reproduced a thousand times for sale as an inexpensive poster. The content has changed not one whit.

To follow the matter a little further, should speech cease to be protected if the drawing (or the poem) is reprinted on cotton (a T-shirt), or on ceramic vessel (a coffee mug) or on plastic (a swizzle stick) instead of on paper or a stretched canvas? The utilitarian function of such objects does not change the nature or expressiveness of the images or text printed on them. Although the situation has not arisen often, the Supreme Court has recognized that clothing and other objects can be vehicles for expression, and hence that their expressive content may be entitled to First Amendment protection.⁵⁰ To claim convincingly, therefore, that speech quality of art is lost when an image is proliferated or attached to a utilitarian object needs a more thoughtful defense than this court, and most other courts before it, have tried to mount.

The California court avoided engaging these complexities, however, by opting to switch the burden of proof to *Saderup* to convince the court that his use of the Three Stooges' image was

49 "Simply put," Judge Fukoto wrote, "although the First Amendment protects speech that is sold ..., reproductions of an image, made to be sold for profit, do not per se constitute speech." *Id.* at 470.

50 *See, e.g.,* *Cohen v. California*, 403 U.S. 15 (1971) (jacket bearing a logo critical of the draft a form of communication); *Tinker v. Des Moines School District*, 393 U.S. 503 (1969) (wearing a black arm band a form of protected communication); *cf. Smith v. Goguen*, 415 U.S. 566 (1974) (conviction for wearing flag sewn on seat of defendant's pants overturned on vagueness grounds but the Court recognized that First Amendment activity was implicated); *Spence v. State of Washington*, 418 U.S. 405 (1974) (fixing a peace symbol to American flag a form of protected communication).

either “art or speech as a constitutional matter,” and then concluding that *Saderup* had failed to satisfy the burden. According to the court, the defendants failed to prove that the reproductions were “expressive of any message, idea, emotion – or anything, other than the likenesses of the Three Stooges.”⁵¹ But ruling that a defendant must prove his entitlement to protection for pictorial representations is an odd tack if one pauses a moment to think about it. If speakers can only claim First Amendment protection if they are first able to convince a judge or a jury that their speech is sufficiently important and weighty to deserve it, it would be tantamount to concluding that only speech that satisfies the personal predilections of the finder of fact is protected. A presumption of protection puts the shoe on the right foot: the burden ought to fall on the party who claims the speech is wrongful.

The court got itself backed into this odd posture, I suspect, because it was understandably keen not to throw out 50 years of legal precedent or to find a state statute unconstitutional. The court admitted that, if it had to treat the defendant’s sketch (when reproduced in multiple copies) as “art” for First Amendment purposes, it “would in essence mean that the First Amendment would shield virtually any representation from coverage by [the state’s right of publicity statute].”⁵²

Well, that is a problem for the publicity tort, all right, and it is why, in my view, Ralph Brown was right to be chary of these sorts of claims. Free speech protection is not only for works of high intellectual value, or expressly political content or, for that matter, only for “fine” or unique works of art as opposed to trivial or widely circulated ones. Making such distinctions engages legislatures, administrative agencies, courts and juries in a highly subjective and elitist enterprise completely alien to the idea that citizens, rather than their government, decide what they want to hear and to say.

Interestingly enough, if the question were turned around, and the issue were the protectability of low-brow works as intellectual

51 *Comedy III*, 80 Cal. Rptr.2d at 470.

property, there is little doubt that the courts would shy away from applying the kind of value-laden test they feel comfortable using in publicity cases. Almost a century ago, the United States Supreme Court said that there was no way to make a principled distinction for purposes of copyright protection between works of high artistic or informative value and ones of merely pedestrian worth. Justice Holmes, writing for the Court in *Bleistein v. Donaldson Lithographing Co.*,⁵³ went through a number of possible grounds on which the Court could deny copyright protection to circus posters depicting acrobats and dancing girls. After rejecting them one by one as too vague and unmanageable, Justice Holmes concluded:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have commercial value – and it would be bold to say they have not an aesthetic and educational value– and the taste of the public is not to be treated with contempt.⁵⁴

Admittedly, copyright and the First Amendment have different objectives, but I think it would be hard to argue that the absence of any principled basis for distinguishing between protected and

⁵³ 188 U.S. 239 (1903).

⁵⁴ *Id.* at 251-52.

unprotected works based on their social “value” is less of a problem for free speech purposes than for intellectual property protection. Clearly, a court is on shaky ground whenever it engages in arbitrary and ad hoc determinations that a commemorative bust of Martin Luther King or Saderup’s images of the Three Stooges are expressive of nothing, whereas Gilbert Stuart’s portraits of George Washington (or Warhol’s Marilyn Monroe, to bring up a more modern example) do express something, and are therefore worthy of constitutional protection.⁵⁵

Acknowledging that the use of celebrity images on posters and T-shirts is a form of speech, some have urged other grounds for subjecting these sorts of expression to regulation.⁵⁶ One approach is to fall back on that convenient old warhorse, *United States v. O’Brien*.⁵⁷ In *O’Brien*, the Supreme Court said that a law against damaging or destroying draft cards did not offend the First Amendment, even though it was used to punish the symbolic speech involved in burning the card as a Vietnam war protest.⁵⁸

55 Vagueness in standards regulating speech is a classic reason to strike down a statute. *Kolender v. Lawson*, 461 U.S. 352, 357 (1983); *NAACP v. Button*, 371 U.S. 415, 432-33 (1963). Scholars on both sides of the argument agree that the images and names of celebrities in our society carry an enormous amount of expressive freight. Indeed, the entire reason that the public desires the commodities bearing such images or names is the meaning invested for them in this information. Among those who have made the case for the symbolic importance of celebrity, see Coombe, *Author/izing the Celebrity*, *supra* note 8; Roberta Rosenthal Kwall, *Fame*, 73 IND. L. J. 1 (1997); Madow, *Private Ownership of Public Image*, *supra* note 8.

56 As my colleague, Bella Lugosi, points out in his contribution to this symposium, amici who have submitted briefs to the California Supreme Court in the appeal of the *Comedy III v. Saderup* decision are relying heavily on *O’Brien* to argue that the use of the Three Stooges’ images is illegal.

57 391 U.S. 367 (1968).

58 U.S. v. *O’Brien*, 391 U.S. 367 (1968). *O’Brien* was a case involving conduct with expressive elements attached; in that way, it differs from the right of publicity, which seeks to regulate expression directly. However, in subsequent cases, conduct that was inextricably connected with expression – for example, posting signs on public property – has been analyzed under *O’Brien*. *Members of City Council of Los Angeles v. Taxpayers for Vincent*, 466 U.S. 789 (1984). Hence, one might argue (although I think it a very big stretch) that the right of publicity is a regulation that bars the “posting” of expressive materials on particular sorts of goods. *O’Brien* set out a four-part test.

Speech activities can be regulated under these circumstances if the law is content-neutral -- that is, if it is aimed at a nonspeech harm that flows from something other than the particular content of the speech. For example, in *O'Brien* the objective was to protect draft cards from intentional destruction or mutilation, irrespective of the reason the damage was inflicted. That rationale does not work so well in publicity rights cases. The harm of which plaintiffs complain in these cases flows directly and solely from speech, and speech with specific content, at that. The harm is the loss of the power to control the value attached to celebrity as expressed to the public through words and images.

Assuming, therefore, as I do, that the regulation of publicity rights can only legitimately be described as content-based, the standard that must be met to justify regulating it is a high one. Based on existing precedent, the state may under certain circumstances meet that burden by demonstrating a direct deprivation of income from one's original works of authorship (or something akin to it) of a sort that deprives the individual of remuneration for his work product. For example, when a television station used Mr. Zacchini's entire act without his permission,⁵⁹ or record pirates copied other people's sound recordings and sold the pirated versions as substitutes for the originals,⁶⁰ the Supreme Court was sufficiently impressed by the need to overcome a potential market failure attributable to the public goods problem associated with such endeavors that it was willing to allow a remedy, even if the subject matter being regulated was clearly a form of speech. But these are unusual kinds of cases; only rarely right of publicity cases have facts comparable to those in *Zacchini*, where specific, complete performances by particular individuals are what is taken. More commonly, the violations occur through the use of someone's

Expressive activity can be regulated if the objective is legitimately within the government's power to achieve, the interest furthered is important, the interest is unrelated to the content of the speech, and any incidental restriction imposed on speech is no greater than necessary to achieve the government's objective. 391 U.S. at 376-77.

59 *Zacchini*, *supra* note 29, 433 U.S. 562 (1977).

60 *Goldstein v. California*, 412 U.S. 546 (1973).

appearance or name or by allusion to her identifying characteristics. These are not cases equivalent to the taking of copyrightable expression. Thus, to defend the publicity right, a simplistic reliance on cases like *Zacchini* will not be enough.

Ralph, in his Brace Lecture, was characteristically generous in refusing to dismiss out of hand the possibility that some countervailing arguments might exist that would sufficiently justify publicity rights in nonadvertising cases -- although he was clearly skeptical about it.⁶¹ I will (also characteristically, I fear) skip the generosity and jump straight to the skepticism.

The most common claim is that the right of publicity is necessary to supply incentives for talented people to engage in the socially useful activity of developing their talent.⁶² This claim can be thought about in two ways -- economic and psychological -- neither of them very satisfactory. The economic argument is that celebrities will under-invest in their careers if they are deprived of the full economic benefit generated by their fame.⁶³ The explanation given for this phenomenon is that information about celebrities is a form of public good, the consumption of which by one person will not reduce the amount available to others. To get people to produce desirable public goods like celebrity or fame, therefore, the law must introduce artificial scarcity by the assignment of exclusive rights. Otherwise, the producer will be unable to use markets to capture enough of the value she creates to compensate her for investing her time, talent and resources in its production. She will then turn to other, more profitable enterprises, and consequently, a market failure will occur.

61 After listing the desire to prevent unjust enrichment as one possible justification for preserving a limited publicity right, for example, Professor Brown could not resist the addition of a damning qualifier: "[W]hat an empty phrase that is," he wrote. Brown, *Upstart Cousins*, *supra* note 2, at 305.

62 Many of the justifications discussed in this section could also be used to explain other common law and statutory forms of intellectual property, but I will focus here solely on their application to publicity.

63 This assumes, of course, that people who become famous do so for personal economic gain -- an argument that might surprise Albert Einstein or Mother Teresa. Nevertheless, any person interesting enough to the public to make the use of their visage or other elements of identity worth attempting to

Copyright is a classic example of the use of a scheme of legal enclosure to fend off the risk that information goods will be under-produced. The Supreme Court in *Zacchini* drew an analogy between copyright and the specific facts of that case (the taking of a particular, complete performance) and concluded that permitting the broadcast of *Zacchini*'s performance without permission posed the same threat of market failure that would exist if whole books could be copied without permission.⁶⁴ It therefore said that state law could legitimately to fend off that risk. It would be hard, however, to parley the rationale for *Zacchini* into the sort of compelling state interest that justifies allowing more ordinary types of publicity claims.⁶⁵ In most such cases, I have argued at greater length elsewhere, the value at issue in the publicity claim is merely a secondary by-product of activities that are engaged in for other reasons.⁶⁶ Not a shred of empirical data exists to show that anyone would change her behavior with regard to her primary activity – that is, that a person would invest less energy and talent in becoming a sports star or entertainer or great civic figure -- if she knew in advance that, after achieving fame, she would be unable to capture licensing fees from putting her face on sweatshirts or coffee mugs. Proof of this can be found in the fact that many countries – Great Britain, for example – produce quite a healthy crop of persons committed to becoming celebrities without the help of a legally recognized publicity right.⁶⁷ But if I am right in my earlier assertion that celebrity will be produced aplenty without the kind of enclosure provided by publicity rights, then it ceases to be evident why a property right should be assigned to further encourage (dare I say, over encourage?) its production.⁶⁸ Thus, this version of the incentives argument does not seem to do the job.

64 *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977)

65 *Id.*

66 Zimmerman, *Publicity*, *supra* note 5, at 77-78.

67 See *Cairns v. Franklin Mint Co.*, 24 F. Supp.2d 1013, 1023-24 (C.D. Cal. 1998) (finding that Britain does not recognize publicity rights).

68 For works discussing economic arguments in favor of the right of publicity, see RICHARD A. POSNER, *ECONOMIC ANALYSIS OF LAW* 225 (1981); William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 362-63 (1989) [hereinafter Landes & Posner];

One could also argue that celebrities will lose incentives to invest in fame because they will be demoralized if they cannot capture the full value of that fame. This argument, too, is suspect for the simple reason that lots of people who generate publicity values have gotten on quite nicely without collecting a cent from them. If British celebrities are demoralized by their failure to have publicity rights, I suspect it is only because they see those rights so temptingly displayed on the other side of the Atlantic. Were none available anywhere, I doubt that anyone's sense of entitlement would be violated.

Other candidates as justifications for publicity rights are the prevention of unjust enrichment, or of free riding on the efforts of others. These rationales, however much they differ from it in other regards, share an assumption in common with the psychological disincentive argument: that there is something unfair about allowing others to participate in the value that is associated with famous people. But is this really so? Or are "unjust enrichment" and "free-riding" simply conclusions dressed up as analysis? I would argue that they are, and that deconstructing them reveals their poverty as justifications.

It actually is far from self-evident why failure to permit celebrities to capture all value that flows from their visages and names is unfair or a form of misappropriation. In many situations, individuals make valuable contributions to the society without any expectation of capturing full remuneration for what they have contributed. Students, for example, are not typically characterized as capturers of unjust gains, or as free-riders, when they put their education to profitable uses without paying ongoing royalties to their teachers. As a result of competition, consumers frequently do not pay every cent of the worth to them of the products they use; we generally think that leaving this surplus with the consumer is good public policy, and not unjust enrichment. As long as the compensation schemes in place are adequate to keep enough good

Timothy P. Terrell & Jane S. Smith, *Publicity, Liberty, and Intellectual Property: A Conceptual and Economic Analysis of the Inheritability Issue*, 34 EMORY L. J. 1 (1985) [hereinafter Terrell & Smith]; Richard A. Posner, *The Right of Privacy*, 12 CAL. L. REV. 393, 411 (1978).

people in teaching or enough companies in the business of making desirable products, who should get the excess value -- producers or consumers -- is a question we determine in light of broader social policy goals. Why should the situation with the excess value of celebrity be different? And the free-rider argument rings a particularly false note in light of the fact that, as has been persuasively argued by others, the public plays at least as great a role in creating the value attached to fame as the celebrity herself.⁶⁹

In the absence of either unfairness or an incentives-based rationale for creating property rights, the only other reason I have come across for why we might want to enclose information about famous people is a “congestion” argument. This suggestion was made in passing by Landes and Posner in discussing why publicity rights ought to endure long after the death of the personality in question, but it is hard to know how seriously to take it.⁷⁰ For this to be a powerful claim, one would need to posit a reason to care about the fact that the value of a persona may be diminished by overuse in the absence of a property regime. The incentive argument might provide such a rationale, but since it does not seem to work very well in publicity cases, what other alternative justification for caring about congestion is available?⁷¹

⁶⁹ See Coombe, *supra* note 8.

⁷⁰ Landes & Posner, *supra* note 68 at 362-63. The authors spend a very brief time on the argument, explaining why publicity rights should persist long after death. They point out that rivalry may occur over uses of the identity of a figure like George Washington, and that congestion, which would lower the value of the right to use Washington’s name or face, could occur without private ownership to permit a market to form that will allocate the rights efficiently. Humorously, the article to which the authors cite as the source of this justification actually rejected it out of hand. Terrell & Smith, *supra* note 68, at 47-49.

⁷¹ Landes and Posner only discuss congestion in the context of asking whether publicity rights should survive the celebrity. They say yes, even though they admit that prevention of free-riding and the provision of proper incentives do not supply a justification for their position. Returns on the investment in the development of celebrity that will not be received until far in the future, they agree, play little role in providing incentives to engage in the activity; if the return on an investment is unlikely to be garnered, not merely in one’s lifetime, but in the fairly near future, the promise of its capture is likely to

Perhaps it is a response to the interests of a different set of beneficiaries -- rival claimants to the resource who want property rules to serve as an allocational mechanism.⁷² This approach supposes potential appropriators who will place different values on the right to use a particular celebrity's attributes. If a "low valuer" is free to appropriate a celebrity image at will, he may do so, and, as a result, cause someone else to whom the image is worth more to forego using it because it is now stale, or insufficiently distinctive, or has otherwise become tarnished for his purposes. With a property regime in place, the higher valuer can instead bargain with the owner for exclusive rights. Thus, publicity law might be thought of as a way to ensure in cases of conflict that a resource is directed to its highest and best use.

There are probably a lot of ways to think about this argument, but at least three responses come to mind. First, there is an empirical question about the size and scope of the "problem" that congestion is likely to cause. Landes and Posner specifically addressed it as an issue for the "advertising value of a name or likeness."⁷³ I can conceive of overuse as a possible problem for advertisers (without necessarily being convinced, however, that the problem is a serious one in need of a legal solution). But I have a much harder time wrapping my mind around even the theoretical

play little role in the calculation about whether or not to invest one's time and talents in that way. Landes & Posner, *supra* note 68, at 361-62.

72 Rival use cases crop up in the case law from time to time. An interesting example of rivalry over the use of a celebrity's name can be found in MJ & Partners Restaurant Limited Partnership, 10 F. Supp. 2d 922 (N.D. Ill. 1998). Michael Jordan sold the right to use his name and persona in conjunction with restaurants in the Chicago area in 1990. Several years later, Jordan and a chef got together and planned to open a restaurant near the home of the Chicago Bulls, which Jordan would help promote and which would display the star's personal humidior (with his name on it) inside the restaurant. The beneficiary of the 1990 agreement sued to enjoin the opening of the restaurant, and the district court ruled against the defendant on a motion to dismiss, finding, among other things, that the plaintiff had stated a claim for violation of Jordan's right of publicity, which, at least in this context, it now owned. *Id.* at 929-31. The original right of publicity case, Haelen Laboratories, Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866 (2d Cir. 1953), also involved a sports star who tried to sell rights to use his image on trading cards to two different companies.

possibility of “congestion” as a serious problem for the kinds of nonadvertising uses this paper addresses, much less why we would want to prevent it by giving exclusive rights to the highest bidder.

Beyond empirics, however, loom larger, normative, questions. Economists are often committed to the view that private property leads to the most efficient exploitation of resources. A considerable body of literature, for example, has been devoted to cataloguing the defects of leaving scarce resources subject to common ownership.⁷⁴ If such resources are not privately owned, the argument goes, they will be subject to overuse and waste. But this argument does not do much in helping to explain why property rights in publicity are a good idea. As already pointed out, the informational and symbolic values associated with celebrity are not scarce resources, and it is not at all clear that they should be treated as if they were. As a society, we are committed to promoting speech, and, logically, to ensuring that anyone who desires it will have reasonable access to the content that makes speaking socially and personally worthwhile.

But even if efficiency arguments favor commodifying information about important or interesting people, we may nevertheless choose to reject markets as the most desirable way to allocate goods on ethical, political and social grounds.⁷⁵ Every society holds some values in sufficient esteem that the thought of subjecting them to markets is perceived as a violation of liberty or as seriously wrong. This country, for instance, does not allow markets in children, or permit individuals to sell themselves to

74 Garrett Hardin, *The Tragedy of the Commons*, 162 SCI. 1243 (1968), reprinted in PERSPECTIVES ON PROPERTY LAW 132 (Robert C. Ellickson, Carol M. Rose & Bruce A. Ackerman eds., 2d ed. 1995).

75 Distributional justice or other ethical considerations, for example, may lead a society to reject the use of markets in certain areas, and even to prefer results that are not efficient. For example, where food is scarce, a society could allow markets to take care of allocation – but it could also conclude that humanitarian and moral considerations demand that food be shared rather than being doled out preferentially to those with greater wealth or the potential of higher levels of productivity. Terrell and Smith, for example, argue that markets are not the proper mechanism for dealing with the values that publicity rights encompass. Terrell & Smith, *supra* note 68, at 49-50.

others as slaves.⁷⁶ While markets provide an efficient mechanism for ranking preferences, some areas exist in which individuals arguably should not be put to, or allowed to make, particular kinds of trades.⁷⁷

Free speech is one of those areas set apart for special treatment and its exercise has historically enjoyed considerable protection from economic markets. It is well established, for example, that in all but the most unusual circumstances,⁷⁸ "newsworthy" content, including information about people, is not subject to private ownership or most other forms of exclusive control.⁷⁹ Speech protection is not limited to things that are newsworthy, of course, and thus by extension, the same reasoning that prohibits ownership of newsworthy information would seem to apply to information used in any other fully protected speech activity.⁸⁰ It would be difficult, if not impossible, to achieve the goals of the First Amendment, whether individual self-realization or informed political participation, without the availability of such a common.⁸¹

76 Margaret Jane Radin, *Market-Inalienability*, 100 HARV. L. REV. 1849 (1987); MARGARET JANE RADIN, *CONTESTED COMMODITIES: THE TROUBLE WITH TRADE IN CHILDREN, BODY PARTS AND OTHER THINGS* (1996); Calabresi and Malamed, *Property Rules, Liability Rules, and Inalienability: One View of the Cathedral*, 85 HARV. L. REV. 1089 (1972).

77 For a provocative argument that efficient outcomes are just, see RICHARD POSNER, *THE ECONOMICS OF JUSTICE*, 13-115 (1981).

78 For examples of such exceptions, see, e.g., Zacchini, *supra* note 29 (use of performer's complete act without permission actionable violation of property right); *International News Service v. Associated Press*, 248 U.S. 215 (1918) (taking of "hot news" an actionable misappropriation of property interest in information).

79 The Supreme Court of the United States did reject a newsworthiness rationale in *Zacchini*, but the subject matter was not the use of a "persona" but rather of an entire videotaped performance.

80 This assumption is reinforced by the interpretation of the copyright clause of the Constitution, requiring that property rights be limited to expression but not to underlying facts and ideas. See, e.g., *Baker v. Selden*, 101 U.S. 99 (1879) (ideas are not protectable but belong to everyone); *Feist Publications, Inc. v. Rural Telephone Service*, 499 U.S. 340 (1991) (facts cannot be copyrighted because they do not meet the constitutional requirement of originality).

81 See generally, Diane Leenheer Zimmerman, *Information as Speech, Information as Goods: Some Thoughts on Marketplaces and the Bill of Rights*, 83 WASH. & LEE L. REV. 665 (1992). For a very interesting defense of a rich

As a practical matter, even with a rich public domain, access to the symbols and informational content of our society admittedly is limited to some significant degree by wealth and social position. The wealthier portion of the population, for example, may receive a superior education or be exposed to a richer array of books, film and other cultural artifacts. But this asymmetry is a problem for speech and democratic theory, and not something we should carelessly aggravate by frank commodification of large chunks of the informational commons. Commodification would mean that even after access to bits of information and to images and symbols has legally been obtained, an additional price tag would be attached to the right to use the information, thereby increasing the wealth effect.

A third argument against commodification is that unavoidable distortions in valuation will lead to unacceptable costs in the form of lost uses. Although would-be users with assets to expend on personal data might arrive at a fairly comfortable system of determining when and how much to pay for a building block of their own speech, the long-term social as well as personal costs of such a system are undesirable.⁸² Sometimes a particular way in which an information fragment is used will not demonstrate its full significance (and worth) for decades. Unexpected circumstances and serendipities change meaning over time. Also, one person's use produces spillovers that benefit others in unexpected ways and lead to new ideas or approaches, but the value of this benefit cannot necessarily be captured by the original user. We can predict, therefore, that commodifying information will lead to its systematic under use. It is not unreasonable for a polity that holds freedom of speech and its social benefits to be a preeminent good to resolve doubts about the effect of markets in speech in favor of

common based on both economic and first amendment theory, *see* Benkler, *supra* note 18.

82 Landes and Posner point out that returns that lie in the distant future are deeply discounted and "have little effect on present decisions." Landes & Posner, *supra* note 68, at 361-62. If this is correct, a user can be expected to forego the use of licenses to use information if a sufficient payback cannot reasonably be anticipated in the short run.

refusing to treat building blocks of expression as a form of private wealth.

The preservation of a rich common has certainly correlated with enormous national success in generating production of a vast array of valuable and innovative information goods, as well as in offering expansive opportunities for individual self-realization. This correlation may be accidental, but I doubt it. The conservative approach, therefore, is one that does not lightly tamper with the public domain. At the very least, anyone who wants to argue in favor of greater commodification of its riches ought to bear the burden of demonstrating a) that the property claim at issue is consistent with the values of the First Amendment, and b) that a market in information can operate with reasonable accuracy. I would bet that the advocates of commodification -- including those who argue that publicity rights are just a small and self-evidently just incursion into the common -- will rarely be able to meet these standards. But, unless they can, the public domain is the perfect place to apply that old maxim, "If it ain't broke, don't fix it." I think both the "Connecticut Yankee" and the civil libertarian in Ralph's soul would resonate with that sentiment if he were here to chime in.

